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09/945,072	08/31/2001	Tom R. Vandermeijden	3399P072	3009

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EXAMINER

ELAHEE, MD S

ART UNIT PAPER NUMBER

2645

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/945,072

Applicant(s)

VANDERMEIJDEN, TOM R.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 69 of copending Application No. 09945414.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 10 of the present invention recites A method of operating a browser in a mobile communication device configured to communicate voice and data over a wireless network, the browser to enable a user of the mobile communication device to access and navigate hypermedia data, the method comprising: receiving a telephone number at the browser in response to the mobile communication device receiving or initiating a voice call over the wireless network; in response to receiving the telephone number, automatically determining whether data of a predetermined type associated with the telephone number is stored in a contact database in the mobile communication device; if the data associated with the telephone number is not stored in the contact database, then waiting to establish a data connection with a remote server via the wireless network, and when the data connection is established, automatically requesting the data

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associated with the telephone number from the remote server via the wireless network, receiving the data associated with the telephone number via the wireless network, and storing the data associated with the telephone number in the contact database in association with the telephone number. Claim 69 of the copending Application recites A method of operating a browser in a mobile telephone configured to communicate voice and data over a wireless network, the browser to enable a user of the mobile telephone to access and navigate hypermedia data, the method comprising: receiving Caller-ID information at the browser in response to the mobile telephone receiving a signal indicating an incoming telephone call over the wireless network; in response to receiving the Caller-ID information, automatically attempting to locate ring tone data associated with the Caller-ID information in a contact database within the mobile telephone; if the ring tone data is found in the contact database, then outputting the ring tone data to a telephony unit of the mobile telephone, the outputted ring tone data for use in generating a ring tone indicating the incoming telephone call; if the ring tone data is not found in the contact database, then waiting to establish a data connection with a remote server via the wireless network, and when the data connection is established, automatically requesting the ring tone data from the remote server via the wireless network, receiving the ring tone data via the wireless network, and storing the ring tone data in the contact database in association with the Caller-ID information. It is clear that these claims are very similar and are not patentably distinct from each other.

***Response to Amendment***

2. This action is responsive to an amendment filed 12/01/04. Claims 1-33 are pending.

***Response to Arguments***

3. Applicant's arguments mailed on 12/01/04 have been fully considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5, 6, 8, 16-18, 20, 21, 23, 25-27, 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enzmann et al. (U.S. Patent No. 6,687,242) in view of Miyashita (U.S. Pub. No. 2002/0019225).

Regarding claims 1 and 16, Enzmann teaches receiving a telephone number associated with a voice call involving the subscriber's handset [i.e., mobile communication device] (fig.1; col.1, lines 36-40, col.3, lines 54-63).

Enzmann further teaches when a data connection is established between the subscriber's handset and a website [i.e., remote processing system] via the wireless network, then automatically obtaining information [i.e., data] associated with the telephone number via the wireless network (col.1, lines 36-50, col.2, lines 8-22, col.3, lines 28-53).

However, it is not clear whether Enzmann teaches storing the data in the contact database in association with the telephone number. Miyashita teaches storing the directory data of records [i.e., data] in the storage unit [i.e., contact database] in association with the telephone number

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(page 2, paragraphs 0020, 0021). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Enzmann to store the data in the contact database in association with the telephone number as taught by Miyashita. The motivation for the modification is to have doing so in order to retrieve contact information from the storage whenever a person needs to contact without any inconvenience.

Regarding claims 2, 17 and 26, Enzmann teaches receiving Caller-ID information including the telephone number and associated with an incoming call to the mobile communication device (col.1, lines 36-40, col.2, lines 8-22).

Regarding claims 3, 18 and 27, Enzmann teaches receiving a telephone number associated with an outgoing call being placed by a user of the mobile communication device (col.1, lines 36-40, col.2, lines 8-22).

Regarding claims 5, 20 and 29, Enzmann teaches a browser to allow a user of the mobile communication device to navigate hypermedia information, and wherein the obtaining the data associated with the telephone number via the wireless network is done automatically by the browser (col.1, lines 36-40, col.2, lines 8-22, col.3, lines 28-53).

Regarding claims 6, 21 and 30, Enzmann teaches automatically requesting the data associated with the telephone number from a remote server via the wireless network when the data connection is established (col.1, lines 48-67, col.2, lines 1-22, col.3, lines 28-53).

Regarding claims 8, 23 and 32, It is not clear whether Enzmann teaches the obtained data associated with the telephone number comprising name or address information associated with the telephone number. Miyashita teaches the obtained data associated with the telephone number comprising name or address information associated with the telephone number (page 2,

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paragraph 0020). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Enzmann to incorporate the obtained data associated with the telephone number comprising name or address information associated with the telephone number as taught by Miyashita. The motivation for the modification is to have doing so in order to keep record of additional information of a contact in storage of a user handset so that he can get the information whenever he needs to contact.

Regarding claim 25 is rejected for the same reasons as discussed above with respect to claims 1 and 5.

6. Claims 4, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enzmann et al. (U.S. Patent No. 6,687,242) in view of Miyashita (U.S. Pub. No. 2002/0019225) further in view of Fleming, III (U.S. Patent No. 6,697,484).

Regarding claims 4, 19 and 28, Enzmann in view of Miyashita fails to teach “attempting to locate the data associated with the telephone number in the contact database, wherein said obtaining data associated with the telephone number via the wireless network is performed only after failing to locate the data in the contact database”. Fleming teaches attempting to locate the alphanumeric identifier (i.e., data) associated with the telephone number in the memory (i.e., contact database), wherein the obtaining alphanumeric identifier (i.e., data) associated with the telephone number via the wireless network is performed only after failing to locate the alphanumeric identifier in the memory (fig.1-fig.4; col.3, lines 54-65, col.4, lines 60-64, col.5, lines 12-27, col.6, lines 4-20). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Enzmann in view of Miyashita to allow attempting to locate the data associated with the telephone number in the contact database, wherein the

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obtaining data associated with the telephone number via the wireless network is performed only after failing to locate the data in the contact database as taught by Fleming. The motivation for the modification is to have doing so in order to retrieve the alphanumeric identifier associated with originator's telephone number via the wireless network.

7. Claims 7, 22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enzmann et al. (U.S. Patent No. 6,687,242) in view of Miyashita (U.S. Pub. No. 2002/0019225) further in view of Ho et al. (U.S. Pub. No. 2002/0194352).

Regarding claims 7, 22 and 31, Enzmann in view of Miyashita fails to teach "the obtained data associated with the telephone number is contained in a vCard". Ho teaches the obtained data associated with the telephone number is contained in a vCard (page 3, paragraph 0019). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Enzmann in view of Miyashita to allow the obtained data associated with the telephone number is contained in a vCard as taught by Ho. The motivation for the modification is to have doing so in order to provide name and office telephone number.

8. Claims 9, 24 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enzmann et al. (U.S. Patent No. 6,687,242) in view of Miyashita (U.S. Pub. No. 2002/0019225) further in view of Armanto et al. (U.S. Patent No. 6,094,587).

Regarding claims 9, 24 and 33, Enzmann in view of Miyashita fails to teach "the obtained data associated with the telephone number comprising ring tone data for use to generate a ring tone indicating the incoming voice call". Armanto teaches the obtained data associated with the telephone number comprising ring tone data for use to generate a ring tone indicating the incoming voice call (col.4, lines 21-24, col.7, lines 36-47, col.8, lines 25-30, col.15, lines 28-33).



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Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Enzmann in view of Miyashita to allow the obtained data associated with the telephone number comprising ring tone data for use to generate a ring tone indicating the incoming voice call as taught by Armanto. The motivation for the modification is to have doing so in order to provide distinctive ringing tone for a particular person.

***Allowable Subject Matter***

9. Claims 10-15 will be allowed if the double patenting rejection is overcome.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lundholm et al. (U.S. Patent No. 6,782,208) teach Wireless communication device and method having coordinated primary and secondary transmitters.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.

MD SHAFIUL ALAM ELAHEE

May 16, 2005



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